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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,604	02/23/2004	Brian Rose	P2492C-961	3218

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EXAMINER	
CASCHERA, ANTONIO A	
ART UNIT	**PAPER NUMBER**
2628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/785,604	ROSE, BRIAN	
	Examiner	Art Unit	
	Antonio A. Caschera	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-27 and 29-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-27 and 29-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. This application is a continuation of app no. 09/805,920 which has been patented, U.S. Patent No. 6,697,079 B2.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 22-27, 29-40, 47-52 and 69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to claim 22, the language of the claim raises questions as to whether the claims (claim 22 and all dependent claims) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, the "method for generating a color palette..." as disclosed in claim 22, is the abstract idea, which does not produce a tangible result. See MPEP 2106 IV (B)(1). Note, although claim 22 has been amended to overcome the previous 35 U.S.C. 101 rejections, according to current USPTO practice, the act of storing data in a computer-readable memory is not seen as producing a tangible result. The Office suggests amending the claim to include a limitation citing the displaying of the color palette on a display device as per claim 41.

In reference to claims 35 and 69, the language of the claims raise questions as to whether the claims (claims 35, 69 and all dependent claims respectively) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, the "computer readable medium embodied with a program which causes a computer to execute the following steps..." as disclosed in claim 35, and the "computer–readable medium having embodied thereon a color palette that is accessed by a computer..." as disclosed in claim 69, are the abstract ideas which do not produce tangible results. See MPEP 2106 IV (B)(1). Note, although claim 35 has been amended to overcome the previous 35 U.S.C. 101 rejections, according to current USPTO practice, the act of storing data in a computer-readable memory is not seen as producing a tangible result. The Office suggests amending the claim to include a limitation citing the displaying of the color palette on a display device as per claim 41.

In reference to claim 47, the language of the claim raises questions as to whether the claims (claim 47 and all dependent claims) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, the "color palette stored on a computer-readable medium for display in a graphical user interface..." as disclosed in claim 47, is the abstract idea, which does not produce a tangible result. See MPEP 2106 IV (B)(1). The Office suggests amending the claim to include a limitation citing the displaying of the color palette on a display device as per claim 41.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said one contiguous grouping" in lines 1-2 of claim 32. There is insufficient antecedent basis for this limitation in the claim since claim 22, from which claim 32 depends upon, recites first, second and third contiguous but not a "one contiguous grouping."

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 22-27 and 29-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,697,079. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Applicant's claims have very close to a one to one correspondence in wording to the above claims found in U.S. Patent No. 6,697,097 except for the limitations that the groupings of colors are adjacent to one another and that the color palette is stored which are obvious based on their identical descriptions. Note, the following claims, claims 22-27 and 29-34 are representative claims meaning claims 35-69 are rejected with similar to rationale as applied to claims 22-27 and 29-34.

The table below shows the correspondence between claim 22 of Applicant's claims and claim 1 of U.S. Patent No. 6,697,097:

Applicant's Claim 22:	**U.S. Patent No. 6,697,097 Claim 1:**
A method for generating a color palette for presentation via a computer user interface to facilitate user selection of colors having a consistent appearance across different platforms during computer-implemented creation of an image, the method comprising the steps of: (lines 1-5)	A method for providing a color palette which facilitates user selection of color shaving consistent appearance across different platforms: (lines 1-3)
determining achromatic colors to be located	determining the achromatic colors to be located

within a color palette; (line 6)	within a color palette; (lines 4-5)
arranging the achromatic colors in a first contiguous grouping within the palette; (lines 7-8)	arranging all the achromatic colors in one contiguous grouping within the palette; (lines 6-7)
placing blends of non web-safe chromatic colors in a second contiguous grouping adjacent to the first grouping within the palette; (lines 9-10)	placing blends of non-web safe chromatic colors in a second contiguous grouping within the palette; and (lines 8-9)
placing web-safe chromatic colors, including blends created from the web-safe chromatic colors, in a third contiguous grouping within the palette adjacent to the second contiguous grouping such that the web-safe chromatic colors can be found in the third contiguous grouping; (lines 11-14)	placing all web-safe chromatic colors, including blends created from the web-safe chromatic colors, in a third contiguous grouping within the palette; (lines 10-12)
wherein a subgroup of web-safe chromatic color blends are arranged within said third grouping to form a square wherein the colors are arranged on one side of a diagonal of the square horizontally in order of decreasing saturation towards said diagonal and vertically in order of decreasing value towards said	wherein a subgroup of web-safe chromatic color blends are arranged within said third grouping to form a square wherein the colors are arranged on one side of a diagonal of the square horizontally in order of decreasing saturation towards said diagonal and vertically in order of decreasing value towards said

diagonal, and the colors in the other side of the diagonal are arranged horizontally decreasing in value towards said diagonal and vertically decreasing in saturation towards said diagonal; and (lines 15-21)	diagonal, and the colors in the other side of the diagonal are arranged horizontally decreasing in value towards said diagonal and vertically decreasing in saturation towards said diagonal (lines 13-22).
storing the generated color palette in a computer-readable memory (line 22).	

It would have been obvious to one of ordinary skill in the art to arrange the achromatic colors adjacent to non-web safe colors and further adjacent to web-safe colors in a color palette since color palettes are themselves a contiguous and organized grouping of colors. Therefore, providing different sets or groups of colors adjacent to one another in a color palette is not a novel as the essence of a color palette is such and is commonly communicated as such via a computer. Also, it would have been obvious to one of ordinary skill in the art to store the color palette on some type of computer-readable medium in order to retrieve and/or display saved color configurations for various applications and various times since U.S. Patent No. 6,697,079 discloses a "computer" for implementing the above disclosed color palette steps (see claim 14), the "computer" inherently comprising of some sort of computer-readable medium capable for storing such a color palette.

In reference to Applicant's claim 23, the limitations of claim 23 can be found in claim 2 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 24, the limitations of claim 24 can be found in claim 3 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 25, the limitations of claim 25 can be found in claim 4 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 26, the limitations of claim 26 can be found in claim 5 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 27, the limitations of claim 27 can be found in claim 6 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 29, the limitations of claim 29 can be found in claim 7 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 30, the limitations of claim 30 can be found in claim 8 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 31, the limitations of claim 31 can be found in claim 9 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 32, the limitations of claim 32 can be found in claim 10 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 33, the limitations of claim 33 can be found in claim 11 of U.S. Patent No. 6,697,079.

In reference to Applicant's claim 34, the limitations of claim 32 can be found in claim 12 of U.S. Patent No. 6,697,079.

Response to Arguments

5. Applicant's arguments, see pages 15-17 of Applicant's Remarks, filed 11/28/06, with respect to the 35 USC 103 rejection of the claims have been fully considered and are persuasive. The prior art rejection of the claims has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00 AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

aac
2/8/07

Antonio Caschera
Patent Examiner

KEE M. TUNG
SUPERVISORY PATENT EXAMINER